

REMARKS

Claims 1, 3-21 are currently pending in the present application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

REJECTION OF CLAIMS UNDER 35 U.S.C. 103

Rejection of Claims 1, 4, 5, 9-12, 15, and 17-21 under 35 U.S.C. 103(a) – Raynal Reference
in view of Blalock Reference

Claims 1, 4, 5, 9-12, 15, and 17-21 are rejected under 35 U.S.C. 103(a) for the reasons set forth in paragraph 3 of the Action on pages 7 to 13. Specifically, claims 1, 4, 5, 9-12, 15, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raynal et al. (U.S. Pat. No. 6,643,389), in view of Blalock et al. (U.S. Pat. No. 5,729,008), which is hereinafter referred to as the Blalock reference.

The rejections under 35 U.S.C. 103 are respectfully traversed, and reconsideration and reexamination of the application is respectfully requested for the reasons set forth hereinbelow.

On page 5 in the first and second paragraphs, on page 6 in the first full paragraph, and on page 9 in the first paragraph, the Action states that since Applicant has incorporated by reference U.S. Pat. No. 5,729,008 (specification, page 8, lines 17-20) and has “disclosed that Blalock describes an exemplary implementation of the navigation engine and the navigation sensor array,” it would have been obvious to combine Raynal with Blalock to obtain the invention as claimed in claim 1.

The Action’s position is strongly contested. The motivation of one of ordinary skill in the art to combine two references cannot be aided or be based upon applicant’s own teachings. The standard of obviousness is measured from the perspective of one skilled in the

art at the time of the invention, but the person who is skilled in the art should not be privy to or have access to the thoughts of the applicant.

Furthermore, MPEP 2129, entitled "Admissions as Prior Art" under the paragraph entitled "Admissions By Applicant Constitute Prior Art," states "when applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections." The example given is In re Nomiya, 509 F.2d 566, 184 USPQ 607, 610 (CCPA 1975) in which figures in the application labeled "prior art" were held to be an admission that what was pictured was prior art relative to applicant's invention. However, the Action has mis-applied MPEP 2129 to the instant case and has incorrectly inferred that the current specification has admitted that U.S. Pat. No. 5,729,008 ('008 patent) is prior art, when in fact no such admission has been made or even remotely implied. For example, nowhere in the specification has applicant stated or admitted that the '008 patent is prior art. Instead, U.S. Pat. No. 5,729,008 is only referenced as one example of how navigation engine 420 and the NSA 410 may be implemented.

Any ambiguity in this matter, if any, which does not appear to exist in this case, should be resolved in favor of the applicant. Consequently, it is respectfully requested that the Action not misuse MPEP 2129 "Admissions as Prior Art" to incorrectly infer an admission that '008 patent is prior art with respect to the current application when in fact no such admission has been made by the current specification.

In view of the foregoing, it is respectfully submitted that applicant's own disclosure has been improperly used as motivation to combine pieces of the Raynal reference with pieces of the Blalock reference to arrive at the claimed invention. For example, on page 5, the Action relies upon a portion of applicant's specification to support a position that it would have been obvious to combine Raynal with Blalock. Moreover, it is respectfully submitted

that without the teachings of the present invention (i.e., applicant's own disclosure), the incorporation of a navigation array with an imaging array in a fingerprint imager would not have been obvious. It is respectfully submitted that the current application's identification that certain technologies of U.S. Pat. No. 5,729,008 may be used for or applied to a fingerprint imaging application is in itself a novel and non obvious departure from prevailing approaches of imaging fingerprints.

Furthermore, Raynal would not be combined with Blalock by one of ordinary skill in the art because of the differences in the field of invention, differences in the type of problem being solved and the differences in design considerations as advanced previously in previously filed papers.

Accordingly, for all the reasons advanced herein and previously, it is respectfully submitted that the Blalock reference is neither in the field of the invention nor reasonably pertinent to the specific problem with which the invention is involved. Consequently, it is respectfully requested that the broad range of the Blalock patent asserted by the Action be appropriately narrowed to give reasonable meaning to the analogous art requirement. When appropriately narrowed, it will become evident that the range of the Blalock reference does not cover the invention as claimed (i.e., Blalock is not in the same field of endeavor as the claimed invention). Moreover, it is respectfully requested that the Action's broad characterization of the problem that Blalock attempted to solve be appropriately narrowed to give reasonable meaning to the analogous art requirement. When appropriately narrowed, it will become evident that the problem that Blalock attempts to solve is very different from the problem addressed by the invention as claimed.

Furthermore, it is respectfully submitted that the claimed invention has been improperly used in hindsight as an instruction manual or "template" to piece together the

teachings of the Raynal reference and the Blalock reference so that the claimed invention is rendered obvious. It is well-settled law that the motivation of one of ordinary skill in the art to combine two references cannot be aided or be based upon applicant's own teachings.

Consequently, it is respectfully submitted that without the teachings of the present invention, the incorporation of a navigation array with an imaging array in a fingerprint imager would not have been obvious. Furthermore, Raynal would not be combined with Blalock by one of ordinary skill in the art because of the differences in the field of invention, differences in the type of problem being solved and the differences in design considerations as advanced previously in previously filed papers.

Page 11, first full paragraph of the Action contains a blanket statement regarding claim 17 that it would have been obvious to have modified Raynal's rectangular sensor array to a 1 by N sensor array because "it requires less space." However, the evidence in the prior art is to the contrary. First, the lack of published references that those skilled in the art did find it not obvious to transition from a N x M to a 1 x M array show a single row fingerprint imager as of the filing date of the current application evidences that and fingerprint imaging products in the marketplace that use only a single row of sensors evidence that it was not obvious to transition from a N x M to a 1 x M array. The claimed invention is the first to confront and solve the

Accordingly, for these reasons, and for the reasons discussed above, it is respectfully submitted that claims 1, 4, 5, 9-12, 15, and 17-21 patentably distinguish over Raynal in view of Blalock. Withdrawal of this rejection under 35 U.S.C. Section 103(a) is respectfully requested.

Claim 3 is rejected under 35 U.S.C. 103(a) for the reasons set forth in paragraph 4 of the Action on pages 13 & 14. Specifically, claim 3 is rejected under 35 U.S.C. 103(a) as being

unpatentable over Raynal et al. (U.S. Pat. No. 6,643,389) and Blalock et al. (U.S. Pat. No. 5,729,008), which is hereinafter referred to as the Blalock reference, and further in view of Bohn et al. (U.S. Pat. No. 6,207,945), which is hereinafter referred to as the Bohn reference.

The Bohn reference is cited for teaching that "the imaging array and the navigation array to share at least one sensor." (Figure 7, col. 14, lines 10-14). The rejections under 35 U.S.C. 103 are respectfully traversed, and reconsideration and reexamination of the application is respectfully requested for the reasons set forth hereinbelow. It is respectfully submitted that the Raynal reference, whether alone or in combination with Blalock and Bohn, fails to teach or suggest the claimed invention. For the reasons advanced previously, Raynal, whether alone or in combination with Blalock, fails to teach or suggest one or more claimed limitations of the independent claims. Bohn does not remedy the deficiencies of Raynal and Blalock.

Moreover, Bohn has been improperly combined with Raynal and Blalock as argued previously in past papers since Bohn neither appears to be in the field of the invention nor appears reasonably pertinent to the specific problem with which the invention is involved. On page 6 second full paragraph, the Action states that Bohn is directed to placement of imaging sensors, which is overly broad characterization and not in agreement with Bohn's own characterization, which is objectively directed to an improved hand-held scanning device (see cols. 1 & 2) and solving problems related thereto. There is no suggestion or even mention of a fingerprint imaging application.

Accordingly, for these reasons, and for the reasons discussed above, it is respectfully submitted that claims 13, 14 and 16 patentably distinguish over Raynal in view of Blalock further in view of Akizuki. Withdrawal of this rejection under 35 U.S.C. section 103(a) is respectfully requested.

Rejection of Claims 13, 14 & 16 under 35 U.S.C. 103(a) – Raynal and Blalock References in
view of Akizuki Reference

Claims 13, 14 & 16 are rejected under 35 U.S.C. 103(a) for the reasons set forth in paragraph 5 of the Action on pages 14 & 15. Specifically, claims 13, 14 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raynal et al. (U.S. Pat. No. 6,643,389) and Blalock et al. (U.S. Pat. No. 5,729,008), which is hereinafter referred to as the Blalock reference, and further in view of Akizuki (U.S. Pat. No. 6,360,004), which is hereinafter referred to as the Akizuki reference.

The Akizuki reference is cited for teaching that “it is known to implement a fingerprint sensor as a touch-pad, or a stand-alone unit, wherein the fingerprint imager further comprises a capacitive sensor having a surface along which a finger is moved and an assembly for housing the capacitive sensor.” In particular, col. 2, lines 62-67 and col. 2, lines 17-20 of Akizuki are cited.

The rejections under 35 U.S.C. 103 are respectfully traversed, at least insofar as applied to the amended claims, and reconsideration and reexamination of the application is respectfully requested for the reasons set forth hereinbelow. It is respectfully submitted that the Raynal reference, whether alone or in combination with Blalock and Akizuki, fails to teach or suggest “the fingerprint imager is implemented in a stand-alone unit and wherein the fingerprint imager further comprises: a) a capacitive sensor having a surface along which a finger is moved; and b) an assembly for housing the capacitive sensor.” For the reasons advanced previously, Raynal, whether alone or in combination with Blalock, fails to teach or suggest one or more claimed limitations of the independent claims. Akizuki does not remedy the deficiencies of Raynal and Blalock, nor does Akizuki supplement the teachings of Raynal and Blalock in a manner to render the claimed invention obvious.

Accordingly, for these reasons, and for the reasons discussed above, it is respectfully submitted that claims 13, 14 and 16 patentably distinguish over Raynal in view of Blalock further in view of Akizuki. Withdrawal of this rejection under 35 U.S.C. section 103(a) is respectfully requested.

Rejection of Claims 6-8 under 35 U.S.C. 103(a) – Raynal and Blalock References in view of
Brownlee Reference

Claims 6-8 are rejected under 35 U.S.C. 103(a) for the reasons set forth in paragraph 6 of the Action on pages 15-16. Specifically, claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raynal et al. (U.S. Pat. No. 6,643,389) and Blalock et al. (U.S. Pat. No. 5,729,008), which is hereinafter referred to as the Blalock reference, and further in view of Brownlee (U.S. Pat. No. 6,282,303), which is hereinafter referred to as the Brownlee reference.

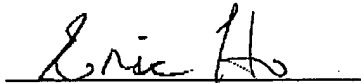
The rejections under 35 U.S.C. 103 are respectfully traversed, and reconsideration and reexamination of the application is respectfully requested for the reasons set forth hereinbelow. The Brownlee reference is cited for teaching the implementation of a fingerprint imager in a stand-alone unit with optics for focusing light onto the surface. For the reasons advanced previously, Raynal, whether alone or in combination with Blalock, fails to teach or suggest one or more claimed limitations of the independent claims. Brownlee does not remedy the deficiencies of Raynal and Blalock, nor does Brownlee supplement the teachings of Raynal and Blalock in a manner to render the claimed invention obvious. Specifically, Raynal, whether alone or in combination with Blalock and Brownlee, fails to teach or suggest, “a) an imaging array having a plurality of sensors arranged along a first axis for capturing a sub-image of the fingerprint at one time; wherein the fingerprint is moved with respect to the imaging array in a direction that is generally perpendicular to the first axis;

and b) a mechanism for determining a change in the position of the fingerprint with respect to time and controlling the image capture of the imaging array," as claimed.

Accordingly, for these reasons, and for the reasons discussed above, it is respectfully submitted that claims 6-8 patentably distinguish over Raynal in view of Blalock further in view of Brownlee. Withdrawal of this rejection under 35 U.S.C. Section 103(a) is respectfully requested.

For all the reasons advanced above, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the pending claims are requested, and allowance is earnestly solicited at an early date. The Examiner is invited to telephone the undersigned if the Examiner has any suggestions, thoughts or comments, which might expedite the prosecution of this case.

Respectfully submitted,




Eric Ho, Reg. No. 39,711
Attorney for Applicant

Law Offices of Eric Ho
20601 Bergamo Way
Northridge, CA 91326

Tel: (818) 998-7220
Fax: (818) 998-7242

Dated: October 19, 2005

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office (fax no.: 571-273-8300) on the date below.


Eric Ho (RN 39,711)

October 19, 2005
(Date)